

RESPONSE AND REQUEST FOR RECONSIDERATION

In response to the Office Action of December 11, 2006 Applicants hereby request the Examiner to reconsider the claims in view of the present amendments and remarks.

The Amendments

Applicants have amended independent claims 1, 19 and 20.

Claims 1 and 19 have been amended to specify that the condensation product of (b) is a hydrocarbyl amide, hydrocarbyl imidazoline or mixtures thereof, having certain defined structures.

Support for the amendment to claims 1 and 19 is provided in claims 4 to 6 as originally filed. Further, the definitions of R⁷ and R⁹ specify “a linear or branched alkyl group”. Support for this phrase is provided in paragraphs [0035] and [0036] of the application as filed.

Claim 20 has been rewritten in independent form, quoting the previous language of claim 1 and specifying that the power transmission system is selected from the group consisting of automatic transmissions, manual transmissions, trans-axles, gears and tractor transmissions. Support for the amendment to claim 20 is provided in claim 1 as previously presented and original claim 21, which specified the nature of the power transmission system.

A new claim 27 has been added, which specifies a method for lubricating an automatic transmission. The lubricant employed is as provided in claim 1 as previously presented.

A new dependent claim 28 has been added. New claim 28 specifies that the alkyl group of the alkyl phosphite contains 14 to 20 carbon atoms. Support for claim 28 is provided in claim 26 as presented Applicant's previous response.

Claim 10 has been amended to correct obvious punctuation errors.

In view of the amendments discussed above, claims 4-6, 21-22 and 26 have been cancelled without prejudice.

Applicants submit that the amended claims are fully supported by the specification and do not add subject matter. No elements other than the nature and chain length of the alkyl groups have been amended.

The Obviousness Rejections

Applicants note with gratitude that the Examiner has withdrawn all objections and rejections, in view of Applicants' submission on September 28, 2006.

The Examiner, however, has raised a new 35 U.S.C. 103(a) rejection to claims 1, 2, 4-22 and 26 in view of Ward (WO 00/70001).

Applicants submit that the claims as amended are unobvious in view of Ward.

The Examiner is of the position that Ward discloses a high boron formulation for continuously variable transmissions. Further, the transmission contains a lubricating

composition prepared by mixing 0.05-5 wt % of a phosphorus anti-wear additive including preferably a phosphite ester having at least 8 carbon atoms. The lubricating composition may also include other common additives including friction modifiers. The Examiner highlighted one such friction modifier derived from isostearic acid condensing with a polyamine.

In fact, Ward merely discloses an exhaustive list of known friction modifiers that could be suitable in a transmission fluid. The list does not disclose or teach a preferred friction modifier to provide appropriate performance. Thus a person skilled in the art would have the expectation that all of the friction modifiers listed in the exhaustive list would have more or less equal performance. However, with regard to claims 1 and 19, the present inventors have unexpectedly discovered that the selection of:

- (i) a particular condensation product of a fatty acid with a polyamine commonly considered to be a friction modifier,

- (ii) an alkyl phosphite, wherein the alkyl group contains 12 to 30 carbon atoms, and

- (iii) the boron-containing additives disclosed in elements (c) and (d),

provides a transmission fluid with acceptable wear resistance, anti-shudder properties, and the appropriate friction properties.

Applicants submit herewith a declaration under Rule 132 by inventor Sumiejski, which provides experimental evidence to support the unexpected performance over the disclosure of Ward. The data demonstrates that the selection of compositions comprising a condensation product of a fatty acid with a polyamine and the alkyl phosphite, i.e., compositions of the present invention, provides improved performance over compositions comprising the alkyl phosphite as highlighted by the Examiner from Ward, that is, without the added condensation product. In particular, when compared against Example 13 of Ward, the addition of even small amounts of the condensation product of isostearic acid with tetraethylenepentamine leads to improved wear and anti-shudder performance.

This unexpected performance was not contemplated by Ward. Accordingly, claims 1 and 19 of the present invention meet the requirements of 35 U.S.C. 103(a) and are unobvious in view of Ward.

Claims 20 and 27 are likewise unobvious in view of Ward. Claims 20 and 27 specify:

- (i) claim 20 a power transmission system is selected from the group consisting of automatic transmissions, manual transmissions, trans-axles, gears and tractor transmissions; or
- (ii) claim 27 an automatic transmission.

For the reasons set forth above for claim 1, the same experimental data submitted in the Rule 132 declaration provides evidence for the unexpectedly performance for a

lubricating composition as specified in current claims 20 and 27. The unexpected performance is suitable for the power transmissions as claimed with acceptable wear resistance, anti-shudder properties, and the appropriate friction properties.

The Examiner has further has entered a new obviousness rejection to claims 12 and 13 in view of Ward and Farnig (US 5,006,270). In view of the unobviousness of independent claims 1, 19, and 20, as discussed above, it is submitted that these narrower dependent claims are likewise unobvious.

For the foregoing reasons it is submitted that the present claims are unobvious and in condition for allowance. The foregoing remarks are believed to be a full and complete response to the outstanding office action. Therefore an early and favourable reconsideration is respectfully requested. If the Examiner believes that only minor issues remain to be resolved, a telephone call to the Undersigned is suggested.

The number of claims, after amendment, is 18, for which no additional fee is due. The number of independent claims is now 3, for which no additional fee is due. Any additional required fees, or any insufficiency or overpayment of fees, should be charged or credited to deposit account 12-2275 (The Lubrizol Corporation).

Respectfully submitted,

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